

C. Remarks

The claims are 1-5 and 12-40, with claims 1, 12, 24 and 28 being independent. Claim 6 has been cancelled without prejudice or disclaimer. The independent claims have been amended to specifically exclude the unit of formula (16). Support for this amendment may be found throughout the specification and in cancelled claim 6. No new matter has been added. Reconsideration of the claims is expressly requested.

The Examiner indicated that he did not consider the Biodegradable Plastics Handbook submission because no adequate translation has been provided. Applicants would like to remind the Examiner that a translation is not required in order to have a foreign language document considered. A concise explanation of its relevance should be sufficient to warrant consideration (37 C.F.R. § 1.98(a)(3)(i)). In this regard, Applicants directed the Examiner's attention to the chemical structures in the cited excerpt from the Biodegradable Plastics Handbook. Clearly, these structures can be considered without any translation. Accordingly, the Examiner is requested to consider the structures and confirm such consideration in writing.

Claims 1-6 and 12-40 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-16 of U.S. Patent No. 6,645,743 B2. Claims 1-6 have also been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by the '743 patent. The grounds of rejection are respectfully traversed, particularly in view of the above amendments.

The Examiner has alleged that formula (1) in the present claims is generic to the structure in claim 2 of the '743 patent when R_3 is $COOR_4$, where R_4 is a hydrogen atom, a sodium atom or a potassium atom. However, the independent claims have now been amended to specifically exclude the 3-hydroxy- ω -(4-vinylphenyl)-alkanoate unit of general formula (1) as recited in claim 1 of the '743 patent (formula (16) in the present case). Since this excluded 3-hydroxy- ω -(4-vinylphenyl)-alkanoate unit is a required component of the copolymer in the claims of the '743 patent, the present claims are clearly not a double patenting of the claims in the '743 patent. Furthermore, these claims are not anticipated by the '743 patent, since the PHA copolymer disclosed in that patent is also required to have the unit of formula (1).

Claims 1-6 and 12-40 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-40 of co-pending Application No. 10/532,136. The grounds of rejection are respectfully traversed.

The Examiner has postulated that the structure of formula (3) in claim 1 of the '136 application can potentially be formula (1) in the present case. However, claim 1 in the '136 application has been amended to exclude R_z that is $C_6H_5-COOR_\alpha$, wherein R_α is H, Na, or K. Thus, clearly, the present claims are not a double patenting of the claims in the '136 application.

Wherefore, withdrawal of the outstanding rejections and expedient passage of the application to issue are respectfully requested.

This Amendment should be entered, because it places the case in allowable form. Alternatively, it places the claims in better form for a possible appeal.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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